

REMARKS

This is responsive to the Office Action of September 22, 2006, in which the Examiner rejected all of the pending claims 1 - 22. Claims 1 - 8, 10 - 20, and 22 were rejected under 35 U.S.C. 103(a) as being unpatentable over Huddleston et al (US 5,653,472) in view of Haas (US 5,785,354) and Attia et al (US 6,016,618). Claims 9 and 21 were rejected under 35 U.S.C. 103(a) as being unpatentable over Huddleston et al in view of Haas and Attia et al as applied to claims 1 - 8, 10 - 20 and 22, above, and further in view of Charles et al (US 4,318,234). As will be explained below, these combinations of references are contrived, and are made only through a hindsight review of the references and their applicability to the rejected claims.

The present application is directed to a printable wristband form which includes a wristband with an opaque portion and an accompanying transparent label that may be affixed to the wristband after printing to protect printed information. The claims specify that the transparent overlamine label is die cut from the same transparent ply as the wristband and that the transparent overlamine label is separate from the wristband. Exemplary is claim 1:

1. A patient wristband form, comprising:

transparent ply having an upper surface and a lower surface,
a pressure sensitive adhesive coating on said lower surface of said transparent ply,
a release ply having an upper surface and a lower surface, said release ply having release coating on said upper surface of said release ply, said transparent ply being removably mounted on said upper surface of said release ply by said pressure sensitive adhesive coating,

a die cut in said transparent ply defining an elongated wristband,

an opaque coating on said upper surface of said transparent ply in a central portion of said elongated wristband, and

a die cut in said transparent ply defining an overlamine label, said overlamine label being separate from said elongated wristband and sized to cover at least a part of said central portion of said elongated wristband so as to cover indicia printed on said opaque coating.

This claim is quite clear in its structural recitation of the wristband form of the present invention.

The Examiner has rejected claim 1 based on a combination of Huddleston, Haas, and Attia. The Examiner states that Huddleston does not show a form with: 1.) A transparent ply; 2.) A die cut in the transparent ply defining an overlamine label; 3.) The overlamine label being separate from the wristband; 4.) An opaque coating on the upper surface of the transparent ply in a central portion the wristband defined by the transparent ply; 5.) The opaque coating defining a coating of a white, opaque ink; 6.) The overlamine label being sized to cover at least a part of the central portion of the wristband so as to cover indicia printed on the opaque coating; 7.) The transparent ply comprising a of a substantially clear polyester material; and 8.) A perforation line extending across the transparent ply between the top ply and the paper ply. Of these eight admitted gaps in the teachings of the Huddleston reference, claim 1 recites items 1, 2, 3, 4, and 6.

The Examiner asserts, however, that these gaps are filled by the teachings of Attia (which the Examiner asserts shows items 1, 2, 3, 6) and Haas (which the Examiner asserts shows items 1 and 4). The Examiner asserts that it would have been obvious to have provided an opaque coating on the upper surface of the transparent ply in a central portion of the elongated wristband in Huddleston "in order to a laminated article that can be printed by sheet fed printers and then converted into an identification wristband that has a covered and protected printed area as taught by Attia and to have a surface that is capable of absorbing ink to form a display as taught by Haas." What the Examiner is really saying here, reduced to its essence, is that it would be obvious to combine the teachings of the Attia and Haas secondary references with those of the Huddleston primary reference because doing so would result in a wristband form that includes the limitations of the claim. This is, at its core, a hindsight rejection. This rejection uses the patent application claim

as the reason for the combination and as a roadmap for the way in which the references are combined. This is simply impermissible.

The Supreme Court has frequently warned against the use of hindsight in determining obviousness. *Diamond Rubber Company of New York v. Consolidated Rubber Tire Company*, 220 U.S. 428 (1911). Lower court decisions criticizing improper use of hindsight are legion. In *re Mahurkar Patent Litigation*, 831 F.Supp. 1354, 28 USPQ2d 1801 (N.D. Ill. 1993), Judge Easterbrook stated that "decomposing an invention into its constituent elements, finding each element in the prior art, and then claiming that it is easy to reassemble these elements into the invention, is a forbidden *ex post* analysis." It is simply impermissible to use the inventor's disclosure as a "road map" for selecting and combining prior art disclosures. In *Interconnect Planning Corp. v. Feil* 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985), the Federal Circuit noted that "The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time." In *re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992), it noted: "[I]t is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. ... This court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.' "

Turning to claim 13, of the eight admitted gaps in the teachings of the Huddleston reference, this claim, like claim 1, specifically calls for items 1, 2, 3, 4, and 6, listed above. That is, claim 13 specifically calls for: 1.) A transparent ply; 2.) A die cut in the transparent ply defining an overlamine label; 3.) The overlamine label being separate from the wristband; 4.) An opaque coating on the upper surface of the transparent ply in a central portion the wristband defined by the transparent ply; and 6.) The overlamine label being sized to cover at least a part of the central portion of the wristband so as to cover indicia printed on the opaque coating. As with claim 1, the rejection of claim 13 is formulated only with the hindsight assistance of the applicants' disclosure and claims. Nothing in the teachings of the references, or elsewhere, would lead a person of ordinary skill in the art to combine the teachings of Huddleston with those of the secondary references.

It is worth noting that the Examiner's discussion of Attia distorts the teachings of this reference. Attia does not teach a die cut in a transparent ply that defines an overlamine label that is separate from the wristband. What Attia shows is a piece of a release sheet carries adhesive, rather than a release coating, and that is attached to the portion of the release sheet that is beneath the printable top ply portion forming the wristband. Note that this arrangement of Attia requires a somewhat complicated pattern coating of adhesive and release material on both the top of the lower ply (the release ply) and the bottom of the upper ply (the printable ply).

Claims 2 - 8, 10 - 12, 14 - 20 and 22 depend either directly or ultimately on claims 1 and 13 and are patentable over the combination of references for the same reasons as presented above with respect to the independent claims.

Claims 9 and 21 have been rejected based upon the same combination of references as used in the rejection of the balance of the claims of the instant application and, in addition, over the Charles patent (US 4,318,234). Charles is cited only as teaching circular cut holes at the ends of a wristband with a clasp that secures these ends together. Charles does nothing to cure the defects in the combination of Huddleston with the Attia and Haas references and, it is submitted, claims 9 and 21 are patentable over this combination of references for the same reasons presented above with respect to claims 1 and 13 from which they respectively depend.

It is submitted that all of the claims of in the present application are patentable over the prior art of record. Early notice of favorable action is respectfully requested.

CONCLUSION

Applicants respectfully submit that the present application is in condition for allowance. The Examiner is encouraged to contact the undersigned to resolve efficiently any formal matters or to discuss any aspects of the application or of this response. Otherwise, early notification of allowable subject matter is respectfully solicited.

Respectfully submitted,

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